

REMARKS

By this amendment, claims 1-15, 17, 21-23, 27-30, 32-41 are pending, in which claims 16, 18-20, 24-26, and 31 were previously canceled without prejudice or disclaimer, claims 37-39 were previously withdrawn from consideration pursuant to the provisions of 35 U.S.C. § 121, claims 1, 12, 21, 27, 35, 36, and 40 are currently amended, and no claims are newly presented. No new matter is introduced.

Accordingly, claims 1-15, 17, 21-23, 27-30, 32-36, 40, and 41 are active.

In its decision of December 24, 2009, the Board of Patent Appeals and Interferences (the “Board”) sustained rejections of claims 1-15, 17, 21-23, 27-30, 32-36, 40 and 41 under 35 U.S.C. § 103(a) based on various combinations of *Liljestrand et al.*, *Bednarek*, *Guidice et al.*, *Sridhar et al.*, and *Bansal*, and sustained a rejection of claims 1-15, 17, 21-23, 40, and 41 under 35 U.S.C. § 101. Specifically, claims 1-4, 7-15, 17, 21-23, 35, and 36 were rejected for obviousness under 35 U.S.C. § 103(a) based on *Liljestrand et al.* in view of *Bednarek*, claims 5 and 6 were rejected for obviousness under 35 U.S.C. § 103(a) based on *Liljestrand et al.*, *Bednarek*, and *Guidice et al.*, claims 27-30 and 32-34 were rejected for obviousness under 35 U.S.C. § 103(a) based on *Liljestrand et al.*, *Bednarek*, and *Sridhar et al.*, and claims 40 and 41 were rejected for obviousness under 35 U.S.C. § 103(a) based on *Liljestrand et al.* in view of *Bansal*. Additionally, the Board entered a new ground of rejection against claim 37 under 35 U.S.C. § 101, in accordance with 37 CFR § 41.50(b), as being directed to non-statutory subject matter.

Respectfully, Applicants note that the Board’s new ground of rejection appears to be in error because claim 37 had already been withdrawn, as noted at page 2 of the principal Brief and page 1 of the Reply Brief. However, rather than file a Request for Rehearing in accordance with 37 CFR § 41.50(b) to have the new ground of rejection withdrawn, Applicants have chosen

to file an amendment under 37 CFR 1.114 in order to resolve the issues remaining under 35 U.S.C. § 101 and 35 U.S.C. § 103(a) in view of the Board's Decision.

As a side note, Applicants point out the inconsistencies in the Board's Decision in holding, in the Conclusions of Law section, at pages 24-25, that the "Appellants have not sustained the burden of showing that the Examiner erred" in rejecting the claims on the various grounds, meaning that the Examiner's rejections were sustained, while, at the same time, indicating in the Decision section, at pages 25-26, that the rejections are "not sustained." Applicants would normally contest such a Decision based on a lack of clarity as to the result. However, in the interest of advancing prosecution without the further delay of having the Board merely reissue its Decision in sustaining the Examiner, Applicants have opted to file this amendment in order to overcome the rejections under 35 U.S.C. § 101 and 35 U.S.C. § 103(a) that were sustained by the Board.

The rejection (and affirmance of the rejection by the Board) of claims 1-15, 17, 21-23, 40, and 41 under 35 U.S.C. § 101 is traversed in view of the current amendments to claims 1, 12, 21, and 40, wherein "a computer program is configured to control a **processor** to perform operations" is now recited. Thus, responsive to the Board's Decision finding that the claimed process was not tied to a particular machine or apparatus, it is now clear that the claimed methods are performed by a **processor** that is controlled by a computer program in order to perform the steps of the claimed methods. Therefore, the claims now recite a particular machine or apparatus, *viz.*, a **processor**, to which the claimed methods are tied.

Accordingly, the Examiner is respectfully requested to withdraw the rejection of claims 1-15, 17, 21-23, 40, and 41 under 35 U.S.C. § 101.

The rejection of claims 1-4, 7-15, 17, 21-23, 35, and 36 under 35 U.S.C. § 103(a) is traversed in view of the amendments to claims to independent claims 1, 12, 21, 27, 35, 36, and 40.

The independent claims now recite either “the procurement inquiry being directed at least to one or more telecommunication services to which a customer who is not yet a subscriber is considering a subscription” and/or “the inquiry being directed at least to the status of the order of the telecommunication service which a customer who is not yet a subscriber has initiated.”

These features clearly distinguish over the references of record. The Board agreed with the Examiner in giving the term “procurement inquiry” a broad interpretation of “obtaining” (Decision-page 16), and deemed the description, in *Liljestrand et al.*, “of requesting or inquiring the system for services and the providing of those services to the user as an act of obtaining services from the system” to be a “procurement inquiry.” However, *Liljestrand et al.*, on which the Board relied, is directed to providing an enhanced telecommunications services platform to **subscribers** of services providing telephone calls. That is, only users who are already subscribers may inquire the system for service and only those services to which a user is subscribed may be obtained from the system. There is no disclosure or suggestion therein of a **prospective** subscriber able to obtain information about the services through a **procurement inquiry**, or of actually ordering such services and checking on the status of such an order, as now specified in the instant claims. Support for the current amendments may be found, for example, at paragraphs [07]-[17] of the instant specification.

Since *Bednarek* does not fill in the gaps of *Liljestrand et al.*, claims 1-4, 7-15, 17, 21-23, 35, and 36 are improperly rejected under 35 U.S.C. § 103(a).

Accordingly, the Examiner is respectfully requested to withdraw the rejection of claims

1-4, 7-15, 17, 21-23, 35, and 36 under 35 U.S.C. § 103(a).

Similarly, since none of the secondary references to *Guidice et al.*, *Sridhar et al.*, and/or *Bansal* cures the deficiency of *Liljestrand et al.* in failing to disclose a procurement inquiry or an order inquiry by a prospective subscriber who does not yet receive the services and/or whose order has not yet been satisfactorily filled, claims 5, 6, 27-30, 32-34, 40, and 41 are also allowable over the applied references.

Accordingly, the Examiner is respectfully requested to withdraw the rejection of claims 5, 6, 27-30, 32-34, 40, and 41 under 35 U.S.C. § 103(a).

Therefore, the present application, as amended, overcomes the rejections of record and is in condition for allowance. Favorable consideration is respectfully requested. If any unresolved issues remain, it is respectfully requested that the Examiner telephone the undersigned attorney at (703) 519-9952 so that such issues may be resolved as expeditiously as possible.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 504213 and please credit any excess fees to such deposit account.

Respectfully Submitted,

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